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To: Commissioner for Patents for <b>Examiner Ming Chow</b> Group Art Unit 2645	Facsimile No.: <b>571/273-8300</b>
From: Michele Morrow Legal Assistant to Francis Lammes	No. of Pages Including Cover Sheet: <b>32</b>
Message:  Enclosed herewith: <ul style="list-style-type: none"><li>• Transmittal Document; and</li><li>• Appeal Brief.</li></ul>	
Re: Application No. 09/942,748 Attorney Docket No: <b>AUS920010578US1</b>	
Date: Tuesday, December 20, 2005	
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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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DEC 20 2005

In re application of: **Himmel et al.**

Serial No.: 09/942,748

Filed: August 30, 2001

For: Apparatus and Method for  
Merging Wireless Telephone Service  
with Existing Wired Telephone  
Equipment in a Facility

35525

PATENT TRADEMARK OFFICE  
CUSTOMER NUMBER

§ Group Art Unit: 2645

§ Examiner: Chow, Ming

§ Attorney Docket No.: AUS920010578US1

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Michele Morrow

TRANSMITTAL DOCUMENTCommissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

ENCLOSED HEREWITH:

• Appeal Brief (37 C.F.R. 41.37).

A fee of \$500.00 is required for filing an Appeal Brief. Please charge this fee to IBM Corporation Deposit Account No. 09-0447. No additional fees are believed to be necessary. If, however, any additional fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0447. No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0447.

Respectfully submitted,

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DEC 20 2005

Docket No. AUS920010578US1

PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Himmel et al.

Serial No. 09/942,748

Filed: August 30, 2001

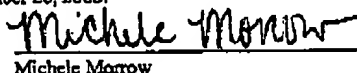
For: Apparatus and Method for  
Merging Wireless Telephone Service  
with Existing Wired Telephone  
Equipment in a Facility§  
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Group Art Unit: 2645

Examiner: Chow, Ming

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By:



Michele Morrow

## APPEAL BRIEF (37 C.F.R. 41.37)

This brief is in furtherance of the Notice of Appeal, filed in this case on October 27, 2005.

The fees required under § 41.20(B)(2), and any required petition for extension of time for filing this  
brief and fees therefore, are dealt with in the accompanying TRANSMITTAL OF APPEAL  
BRIEF.

12/21/2005 MGE BREM1 00000097 090447 09942748

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(Appeal Brief Page 1 of 30)  
Himmel et al. - 09/942,748

**REAL PARTY IN INTEREST**

The real party in interest in this appeal is the following party: International Business Machines Corporation.

**RELATED APPEALS AND INTERFERENCES**

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal, there are no such appeals or interferences.

**STATUS OF CLAIMS****A. TOTAL NUMBER OF CLAIMS IN APPLICATION**

Claims in the application are: 1-7, 10-15, 18-24, and 28-30.

**B. STATUS OF ALL THE CLAIMS IN APPLICATION**

1. Claims canceled: 8, 9, 16, 17, and 25-27.
2. Claims withdrawn from consideration but not canceled: NONE.
3. Claims pending: 1-7, 10-15, 18-24, and 28-30.
4. Claims allowed: NONE.
5. Claims rejected: 1-7, 10-15, 18-24, and 28-30.
6. Claims objected to: 5, 13, and 22.

**C. CLAIMS ON APPEAL**

The claims on appeal are: 1-7, 10-15, 18-24, and 28-30.

**STATUS OF AMENDMENTS**

There are no amendments after the final rejection.

(Appeal Brief Page 5 of 30)  
Himmel et al. - 09/942,748

**SUMMARY OF CLAIMED SUBJECT MATTER*****Independent claims 1, 11, and 19:***

The present invention provides a method of routing calls to wired telephone devices in a facility. (Specification, page 11, lines 16-24) The present invention receives a call directly from a wireless network. (Specification, page 12, lines 7-9) The present invention converts the call to a wired telephone network format. (Specification, page 12, lines 9-11) The present invention forwards the call to a wired telephone device without routing the call through a wired telephone network external to the facility. (Specification, page 12, lines 11-15, and page 12, line 29, to page 13, line 10) The present invention determines a location of a wireless telephone device associated with the facility. (Specification, page 17, lines 6-8) The present invention routes the call to the wireless telephone device based on the location of the wireless telephone device, wherein the call is routed to the wireless telephone device only when the location of the wireless telephone device is not a location within the facility. (Specification, page 17, lines 8-18)

The apparatus recited in claim 11, as well as dependent claims 12-15, 18, and 29, may be an apparatus for routing calls to wired telephone devices in a facility comprised of a facility wired network interface 230; a wireless network interface 240; and a controller 210 coupled to both the facility wired network interface and wireless network interface performing the steps described in the specification at page 12, lines 5-15, page 12, line 29, to page 13, line 10, and page 17, lines 1-18, or equivalent. A person having ordinary skill in the art would be able to derive computer instructions on a computer readable medium as recited in claim 19, as well as dependent claims 20-24 and 30, given Figures 3A and 6 and the corresponding description at page 12, lines 5-15, page 12, line 29, to page 13, line 10, and page 17, lines 1-18, without undue experimentation.

**GROUND OF REJECTION TO BE REVIEWED ON APPEAL****A. GROUND OF REJECTION (Claims 1, 11, and 19)**

Claims 1, 11, and 19 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**B. GROUND OF REJECTION (Claims 28, 29, and 30)**

Claims 28, 29, and 30 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**C. GROUND OF REJECTION (Claims 1, 11, and 19)**

Claims 1, 11, and 19 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

**D. GROUND OF REJECTION (Claims 1, 11, and 19)**

Claims 5, 13, and 22 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

**E. GROUND OF REJECTION (Claims 1-4, 6, 7, 11, 12, 14, 15, 19, 20, 21, 23, 24, and 28-30)**

Claims 1-4, 6, 7, 11, 12, 14, 15, 19, 20, 21, 23, 24, and 28-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Torrey et al. (U.S. Patent No. 6,466,799 B1) in view of Wang et al. (U.S. Patent No. 6,934,543).

**F. GROUND OF REJECTION (Claims 5, 10, 13, 18, and 22)**

Claims 5, 10, 13, 18, and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Torrey et al. (U.S. Patent No. 6,466,799 B1) in view of Wang et al. (U.S. Patent No. 6,934,543), as applied to claim 1, and further in view of Pinard et al. (U.S. Patent No. 5, 454, 032).

### ARGUMENT

#### **A. 35 U.S.C. § 112, Second Paragraph, Claims 1, 11, and 19**

The Office Action rejects claims 1, 11, and 19 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is respectfully traversed.

The Office Action states:

The phrase "determine a location of a wireless telephone device associated with the facility" (line 7) is not clearly defined. It is unclear what is referred by the claimed "associated with". Is it "a location...associated with the facility" or "a wireless telephone device associated with the facility"?

Claim 1, which is representative of the other rejected independent claims 11 and 19 with regard to similarly recited subject matter, reads as follows:

1. A method of routing calls to wired telephone devices in a facility, comprising:
  - receiving a call directly from a wireless network;
  - converting the call to a wired telephone network format;
  - forwarding the call to a wired telephone device without routing the call through a wired telephone network external to the facility;
  - determining a location of a wireless telephone device associated with the facility; and
  - routing the call to the wireless telephone device based on the location of the wireless telephone device, wherein the call is routed to the wireless telephone device only when the location of the wireless telephone device is not a location within the facility.

Appellants respectfully submit that the claim language clearly points out and distinctly claims the subject matter which Appellants regard as the invention. According to conventional rules of grammar, the participial phrase beginning with "associated," should modify the closest noun phrase, which in this case is "telephone device." Applying these rudimentary rules of grammar, the phrase "determining a location of a wireless telephone device associated with the facility" clearly states to one of ordinary skill in the art that a location is determined of a wireless device, the wireless device being associated with the facility. This claim language is clearly supported in Figure 6 and the supporting description on page 17, lines 1-18, of the current

specification. Accordingly, Appellants respectfully request that the rejection of claims 1, 11, and 19 under 35 U.S.C. § 112, second paragraph not be sustained.

**B. 35 U.S.C. § 112, Second Paragraph, Claims 28, 29, and 30**

The Office Action rejects claims 28, 29, and 30 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is respectfully traversed.

The Office Action states:

The phrase "the determination" is not clearly defined. It is unclear the claimed "determination" refers to "determining" (line 2 claim 28), or "determining a location" (line 7, claim 1).

Claim 28, which is representative of the other rejected independent claims 29 and 30 with regard to similarly recited subject matter, reads as follows:

28. The method of claim 1, further comprising:  
determining when to route the calls to the wired or wireless telephones associated with the facility; and  
routing the call based upon the determination.

Appellants respectfully submit that the claim language clearly points out and distinctly claims the subject matter which Appellants regard as the invention. The phrase "the determination" is predicated by "routing the called based." Thus, one of ordinary skill in the art would clearly understand that "routing a call based on the determination" would refer to "determining when to route the calls to the wired or wireless telephones associated with the facility," as stated in line 2 of claim 28 and not "determining a location of a wireless telephone device associated with the facility" as in line 7 of claim 1. This claim language is clearly supported on page 13, line 16 to page 15, line 9, and Figure 4 of the current specification. Accordingly, Appellants respectfully request that the rejection of claims 28, 29, and 30 under 35 U.S.C. § 112, second paragraph not be sustained.

The Office Action further states:

The phrase "determining when to route the calls to the wired or wireless telephones associated with the facility" is not clearly defined. It is what is

referred by "associated with the facility. Is it "the calls....associated with the facility" or "the wired or wireless telephones associated with the facility"?

Claim 28, which is representative of the other rejected independent claims 29 and 30 with regard to similarly recited subject matter, reads as follows:

28. The method of claim 1, further comprising:  
determining when to route the calls to the wired or wireless telephones associated with the facility; and  
routing the call based upon the determination.

Appellants respectfully submit that the claim language clearly points out and distinctly claims the subject matter which Appellants regard as the invention. Again, conventional rules of grammar dictate that the participial phrase modifies the closest noun phrase. Thus, the phrase "determining when to route the calls to the wired or wireless telephones associated with the facility" clearly states to one of ordinary skill in the art that when to route the calls to the wired or wireless telephones is determined, the wired or wireless telephones being associated with the facility. This claim language is clearly supported on page 13, line 16 to page 15, line 9, and Figure 4 of the current specification. Accordingly, Appellants respectfully request that the rejection of claims 28, 29, and 30 under 35 U.S.C. § 112, second paragraph not be sustained.

**C. 35 U.S.C. § 112, First Paragraph, Claims 1, 11, and 19**

The Office Action rejects claims 1, 11, and 19 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This rejection is respectfully traversed.

The Office Action states:

The limitations cited by "determine a location of a wireless telephone device associated with the facility" (line 7) contradicts the limitation of "the location of the wireless telephone device is not a location within the facility" (line 11). The "a location....associated with the facility" (line 7) is interpreted as "a location....within the facility". Therefore, this limitation (line 7) contradicts with limitation on line 11 where cites "the location....is not within the facility".

Claim 1, which is representative of the other rejected independent claims 11 and 19 with regard to similarly recited subject matter, reads as follows:

1. A method of routing calls to wired telephone devices in a facility, comprising:
  - receiving a call directly from a wireless network;
  - converting the call to a wired telephone network format;
  - forwarding the call to a wired telephone device without routing the call through a wired telephone network external to the facility;
  - determining a location of a wireless telephone device associated with the facility; and
  - routing the call to the wireless telephone device based on the location of the wireless telephone device, wherein the call is routed to the wireless telephone device only when the location of the wireless telephone device is not a location within the facility.

Appellants respectfully submit that the claim language is described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, is capable of making and/or using the invention. As stated previously, the phrase "determining a location of a wireless telephone device associated with the facility" clearly states to one of ordinary skill in the art that a location is determined of a wireless device, the wireless device being associated with the facility. This claim language is clearly supported in Figure 6 and the supporting description on page 17, lines 1-18, of the current specification. The claim clearly states that a location is determined of a wireless telephone device, where the wireless telephone device is associated with the facility. There is no limitation implied in the claim that states that the location is associated with the facility, therefore, the location may be within or outside of the facility. Thus, "routing the call to the wireless telephone device based on the location of the wireless telephone device, wherein the call is routed to the wireless telephone device only when the location of the wireless telephone device is not a location within the facility" does not contradict the "determining a location of a wireless telephone device associated with the facility," rather, it defines when a call is to be routed. Accordingly, Appellants respectfully request that the rejection of claims 1, 11, and 19 under 35 U.S.C. § 112, first paragraph not be sustained.

**D. 35 U.S.C. § 112, First Paragraph, Claims 5, 13, and 22**

The Office Action rejects claims 5, 13, and 22 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This rejection is respectfully traversed.

The Office Action states:

The phrase "the call has an associated address.... wherein the associated address is a geographic location of the facility" is not disclosed by the specification. The current specification disclosed on line 31 page 3 to line 11 page 4, *a call is received for the telephone number associated with the wireless telephone and the wireless telephone uses its location determination device to determine the location*. The location determination device was used to determine the location of the wireless telephone. The call, before the call is forwarded, was made based on the telephone number and has nothing to do with the telephone location. The "telephone number" can be interpreted as an "address". However, when the "address" is further claimed to be a "geographic location" the claim, as a whole, is not supported by the specification. Further, it is no obvious for one skilled in the art to implement a phone call based on the receiving party's geographic location.

Claim 5, which is representative of the other rejected independent claims 13 and 22 with regard to similarly recited subject matter, reads as follows:

5. The method of claim 1, wherein the call has an associated address, and wherein forwarding the call to a wired telephone device includes looking up the associated address in a directory of wired telephone devices associated with the facility, wherein the associated address is a geographic location of the facility and wherein determining if the last reported location of the wireless telephone device coincides with the geographical location of the facility with which the wireless telephone unit is associated.

Appellants respectfully submit that the recitation of Appellants specification is incomplete and inaccurate. Appellant's specification at page 3, line 31, to page 4, line 11, reads as follows:

In addition, the wireless telephone may be equipped with a location determination device that determines the wireless telephone's geographic location. This geographic location may be reported to the wireless service